

### **REMARKS**

The Office Action dated October 7, 2003 has been received, its contents carefully noted, and the applied citations thoroughly studied. Accordingly, the foregoing revisions to the claims are tendered with the conviction that patentable contrast has now been made manifest over the known prior art and certain typographical inexactitudes have been rectified to provide better form. Accordingly, all rejections tendered by the Examiner in the above-referenced Office Action are hereby respectfully traversed and reconsideration is respectfully requested.

It is believed that the foregoing revisions to the claims are within the metes and bounds of the recently articulated Supreme Court *Festo* case, in that all equivalents susceptible to capture have been retained in that one skilled in the art, at the time of this amendment, could not have reasonably be expected to have drafted a claim that would have literally encompassed any other equivalent.

#### **Rejections under 35 U.S.C. § 103**

The Examiner has rejected claims 1, 3, 6 through 13, and 15 through 23 under 35 U.S.C. § 103(a) as being unpatentable over Bessho'169 in view of Arnold (GB) '781.

With regard to Bessho '169, undersigned respectfully submits that the symbol-moving features of the instant invention are enabled only if the initial outcome is not recognized by the payable. If the initial outcome is recognized by the payable, the player is awarded and the game ends. If, and only if, the initial outcome is not present on the payable, then the visible symbols are compared to the payable according to a rule set. Bessho's specific condition detecting circuit (47) is always active after the reels (5 to 9) stop moving (col. 3, lines 51-58), so the output is only

checked against the payable once. By contrast, an additional condition is present in the present invention.

The Examiner has cited Arnold (GB) '781 for teaching "a fruit machine having the equivalent means to award if the first outcome is recognized on the payable" (page 5 of the Office Action). Page 1, line 130 through page 2, line 3 of Arnold states "the selector then determines on a random basis whether or not a primary nudge feature game is to be made available to a player". Also, "the secondary feature game is only available on a random basis" (page 2, lines 109-110).

With respect to the combination of Bessho and Arnold:

Claim 1 specifically requires "means to bestow an award if said first outcome is recognized on said payable". The Examiner concedes that Bessho does not contain this element (page 3 of the Office Action). Claim 1 further requires that the processor-activated means to change the location of one or more symbols" is activated "**only** if said first outcome is not recognized by said payable **and only when** said one or more symbols can move from their first outcome orientation to a different area in said RXC matrix according to a rule set to provide a second outcome, such that said second outcome is recognized by said comparison means to be on said payable" (emphasis added). That is, claim 1 requires that the symbols only move from their first orientation to a second orientation if they can produce a winning outcome in the second orientation. This a specific condition that must be satisfied.

Conversely, Bessho's specific prize detecting circuit detects whether one particular outcome is obtained, whether it is one symbol (col. 4, lines 31-32) or a

specific combination of symbols (col. 3, lines 55-56). Bessho does not disclose evaluation of the displayed symbols against a paytable.

Moreover, the nudge game of Arnold (whether primary or secondary) is player-controlled. “[d]uring the period of the timer (10) the player is able to step the reels (1 to 3), one at a time in individual steps corresponding to one symbol position on the reel periphery” (page 2, lines 6-10; similarly in page 2, lines 77-79). In the instant invention, the processor makes the comparisons and performs the reorientation.

At page 4 of the Office Action, the Examiner states that the fact that the reorientation is processor-activated is of no import: “it has been held that broadly providing a mechanical or automatic means to replace manual activity which has accomplished the same result involves only routine skill in the art” (citation omitted). This is not the mere replacement of manual activity with automatic means. *The same result is not accomplished.* Arnold allows the player to step the reels to obtain different results with no guarantee of winning. In the instant invention, the mechanical manipulation of the outcome only occurs when the player can be awarded by the movement.

The claimed invention requires a comparison of the initial outcome to a paytable for awards, a second comparison to the paytable to determine if a winning outcome can be made, and an automatic reorientation only if a winning outcome is found. Bessho does not perform the first comparison. Arnold allows a second game on a random basis only, and that second game does not guarantee an award. Every claim has been amended to make this distinction explicit.

In addition to these distinctions, the Examiner's kind attention is drawn to the following specific issues:

Claim 3 includes the limitations of claim 1, which are not satisfied by the Examiner's combination of references. Bessho discloses movement of particular reels, which correlates to moving symbols in a column, but does not disclose movement along a row or a diagonal, as claimed.

Claim 10 includes the limitations of claim 1, which are not satisfied by the Examiner's combination of references. Claim 10 further requires, if more than one possible winning outcome can be made by reorienting symbols, that the outcome is reoriented to the highest possible value reorientation. No such limitation is contemplated by the Examiner's combination of references.

Claim 11 includes the limitations of claim 1, which are not satisfied by the Examiner's combination of references. Claim 11 further requires, if more than one possible winning outcome can be made by reorienting symbols, that the outcome is reoriented to the lowest possible value reorientation. No such limitation is contemplated by the Examiner's combination of references.

Claim 13 includes the limitations of claim 1, which are not satisfied by the Examiner's combination of references. Claim 13 requires that the "processor-activated means to change the location of one or more symbols...is not active during all times of operation". Bessho's specific prize detecting circuit is always active.

Claim 17 includes the limitations of claim 1, which are not satisfied by the Examiner's combination of references. Claim 17 requires that the "symbols are derived from a conventional deck of playing cards" and "processor-activated means

to change suit". No such limitation is present in Bessho. The use of cards as symbols is not a mere aesthetic symbol change, and the means to change suit are a refinement of the operation of the reorientation means as opposed to when more traditional slot machine style symbols are reoriented.

Claim 21 includes the limitations of claim 20, which are not satisfied by the Examiner's combination of references. Claim 21 further requires, if more than one possible winning outcome can be made by reorienting symbols, that the outcome is reoriented to the highest possible value reorientation. No such limitation is contemplated by the Examiner's combination of references.

In addition, the Examiner does not specifically disclose where each element of the claimed invention is present, merely citing the entire disclosure of Bessho for each individual element.

It is Black Letter Law the Patent and Trademark Office's burden is to establish a prima facie case of obviousness. The Patent and Trademark Office has met its burden only when it fully describes: "1) What the reference discloses, teaches and suggests to one skilled in the art; 2) What the reference lacks in disclosing, teaching or suggesting vis-à-vis the claimed features; 3) What particular teaching or suggestion is being relied upon either via a reference itself or knowledge of person of ordinary skill in the art; 4) A statement explaining the proposed modification in order to establish the prima facie case of obviousness; and finally 5) the motivation behind the statement of obviousness which comes from three sources: a) teachings of the prior art; b) nature of the problem to be solved; or c) knowledge of persons of ordinary skill in the art", see *In re Rouffet*, 47 USPQ2d 1453 (Fed. Cir. 1998).

Combining a comparison of the initial outcome to a payable, as found in Arnold, with the invention of Bessho is flawed. Bessho intentionally does not perform an initial comparison, allowing the player to receive a benefit that the player did not anticipate. Bessho specifically mentions that this is to provide increased player interest (col. 2, lines 28-30). Adding Arnold in this manner thus does violence to Bessho. In addition, as noted in detail hereinabove, Bessho does not provide all of the remaining elements of the claimed invention.

In view of the foregoing, it is respectfully requested that the Examiner pass this case to issue. If, upon further consideration, the Examiner believes further issues remain outstanding or new ones have been generated, undersigned respectfully requests that the Examiner call undersigned to expeditiously resolve same.

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Respectfully Submitted:



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